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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91192099
Party	Defendant McSweet, LLC
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Submission	Motion to Amend/Amended Answer or Counterclaim
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Date	04/23/2010
Attachments	90990.PDF ( 8 pages )(244226 bytes )

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of:  
Application Serial No. 77/722,272  
Published in the *Official Gazette*  
September 1, 2009

McDONALD's CORPORATION,	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. 91192099
	)	
McSWEET, LLC,	)	
	)	
Applicant.	)	

**APPLICANT'S ANSWER TO OPPOSER'S AMENDED NOTICE OF OPPOSITION  
AND COUNTERCLAIMS**

Applicant, McSWEET, LLC, for its amended answer to the Amended Notice of Opposition filed by McDONALD'S CORPORATION ("McDonalds"), against application for registration of McSWEET's trademark MCSWEET, Serial No. 77722272 filed April, 24, 2009, and published in the Official Gazette of September 1, 2009, pleads, avers, and seeks relief as follows:

**ANSWER**

1. Answering paragraph 1 of the Amended Notice of Opposition, Applicant admits the allegations thereof.
2. Answering paragraph 2 of the Amended Notice of Opposition, Applicant admits the allegations thereof.

3. Answering paragraph 3 of the Amended Notice of Opposition, Applicant does not have sufficient knowledge or information to form a belief as to the allegations contained therein and accordingly denies the allegations.

4. Paragraph four (4) was not listed in Opposer's Amended Notice of Opposition.

5. Answering paragraph 5 of the Amended Notice of Opposition, Applicant does not have sufficient knowledge or information to form a belief as to the allegations contained therein and accordingly denies the allegations.

6. Answering paragraph 6 of the Amended Notice of Opposition, Applicant does not have sufficient knowledge or information to form a belief as to the allegations contained therein and accordingly denies the allegations.

7. Answering paragraph 7 of the Amended Notice of Opposition, Applicant does not have sufficient knowledge or information to form a belief as to the allegations contained therein and accordingly denies the allegations.

8. Answering paragraph 8 of the Amended Notice of Opposition, Applicant does not have sufficient knowledge or information to form a belief as to the allegations contained therein and accordingly denies the allegations.

9. Answering paragraph 9 of the Amended Notice of Opposition, Applicant denies each and every allegation contained therein.

10. Answering paragraph 10 of the Amended Notice of Opposition, Applicant admits that it filed the Subject Application, Application Serial No. 77/722,272, and denies each and every remaining allegation contained therein.

11. Answering paragraph 11 of the Amended Notice of Opposition, Applicant denies each and every allegation contained therein.

12. Answering paragraph 12 of the Amended Notice of Opposition, Applicant denies each and every allegation contained therein.

13. Answering paragraph 13 of the Amended Notice of Opposition, Applicant denies each and every allegation contained therein.

14. Answering paragraph 14 of the Amended Notice of Opposition, Applicant denies each and every allegation contained therein.

15. Answering paragraph 15 of the Amended Notice of Opposition, Applicant denies each and every allegation contained therein.

### **AFFIRMATIVE DEFENSES**

16. Applicant further affirmatively alleges that as a result of its continuous substantial usage of its mark MCSWEET since adoption, this mark is a valuable asset of Applicant and carries considerable goodwill and consumer acceptance of its products sold under the mark. Such goodwill and widespread usage has made the mark distinctive to the Applicant.

17. Applicant further affirmatively alleges that there is no likelihood of confusion, mistake or deception because, *inter alia*, Applicant's mark and the pleaded marks of Opposer are not confusingly similar. Any similarity, if at all, between Applicant's mark and the pleaded marks of Opposer is in the portion "Mc" which, upon information and belief, has been used and registered by numerous third parties in the foods, restaurant, processed foods and alcoholic beverages businesses. As a result, Opposer cannot base any similarity between its pleaded marks and the mark of Applicant of the "Mc." Any trademark or service mark rights that Opposer may have are narrowly circumscribed to the goods or services indicated and any other use would not lead to a likelihood of confusion.

18. Applicant further affirmatively alleges that there is no likelihood of dilution of Opposer's mark by tarnishment because, inter alia, Opposer's marks are associated with inexpensive, convenient or easy but low quality or commercialized versions of items whereas Applicant's mark is associated with high quality gourmet products.

19. Applicant further affirmatively alleges that there is no likelihood of dilution by blurring because, inter alia, Opposer's and Applicant's marks are not sufficiently similar; there are, upon information and belief, numerous uses and registrations of third party marks with the "Mc" formative; neither Applicant nor Applicant's predecessors in interest intended any association with Opposer's marks or any of them; and upon information and belief, ordinary prospective purchasers of Applicant's products do not associate Applicant's and Opposer's marks.

20. Applicant further affirmatively alleges that there is no evidence that Applicant is not the actual owner of the MCSWEET mark and all available evidence supports that Applicant's use of MCSWEET in connection with pickled asparagus evidences and demonstrates McSweet, LLC's ownership of the mark.

#### **AMENDED COUNTERCLAIM**

Applicant, McSWEET, LLC, doing business at P.O. Box 607, Maple Valley, Washington, 98038, believes that it will be damaged by Registration No. 1,450,104 for the mark McNUGGETS registered to Opposer, McDONALD'S CORPORATION ("McDonald's"), located at McDonald's Plaza, Oak Brook, Illinois, 60531. Applicant hereby reinstates and restates its petition to cancel in its entirety the registration of the listed mark.

Applicant alleges and seeks relief as follows:

21. Applicant has continuously used the mark McSWEET since September 4, 2008, to the present, exclusively in interstate commerce and in commerce regulated by Congress in connection with Applicant's goods and services, including the sale of "pickled asparagus" in International Class 29.

22. Applicant has used its global mark continuously for the goods and services specified for a period exceeding one year and the mark has acquired distinctiveness in connection with Applicant's goods and services.

23. Applicant has previously filed for registration of the mark McSWEET for use in connection with various pickled vegetable products, and has since amended its designation to "pickled gourmet vegetables, namely, pickled cocktail onions, pickled garlic, pickled, marinated olive medley, pickled green beans, and giardiniera, namely, a pickled celery, carrot, red pepper, garlic, green bean, and cucumber mix," also in International Class 29. Applicant and its predecessor in interest have used the mark continuously for pickled vegetables for a period exceeding 19 years and the mark has acquired distinctiveness in connection with Applicant's goods and services.

24. Applicant has applied for registration of its mark in International Class 29, Serial No. 77,722,272 as follows:

IC 029. US 046. G & S: Pickled asparagus.  
FIRST USE: 20080904.  
FIRST USE IN COMMERCE: 20080904

25. Applicant has used the mark McSWEET, in connection with various pickled vegetable products, since at least as early as 1999, and in connection with pickled asparagus since 2008; and Applicant's predecessor first used his mark in commerce since at least as early

as 1990, in connection with processed vegetables. Opposer cites the referenced mark in support of its opposition to registration.

26. Applicant has expended considerable effort and expense in promoting its mark McSWEET and the goods and services sold under such mark, with the result that the purchasing public has come to know, rely upon, and recognize the products of Applicant by such mark. Applicant has an exceedingly valuable goodwill established by its McSWEET mark.

27. Applicant's McSWEET mark is not confusingly similar to Opposer's marks identified above and the goods and services sold under Opposer's marks.

28. Registration No. 1,450,104 is registered in International Class 042 in connection with "restaurant services." Registration No. 1,450,104 should be canceled under the Trademark Act § 14, 15 U.S.C. § 1064, as abandoned for nonuse in connection with the services specified in the registration. Upon information and belief McDONALD'S CORPORATION has a product on its menu and not a restaurant service that relates to this mark. Upon information and belief, McDONALD'S CORPORATION never used or has discontinued the use of this mark in connection with restaurant services and it is no longer in existence or good standing.

Wherefore, Applicant deems that it is or will be damaged by Registration No. 1,450,104 for the mark McNUGGETS and petitions for cancellation thereof in its entirety. Applicant prays that this Petition for Cancellation be granted, that judgment be entered against Opposer, and that United States Registration No. 1,450,104 be canceled.

Dated this 23rd day of April, 2010.

Respectfully submitted,

McSWEET, LLC

By: /Katherine Hendricks/  
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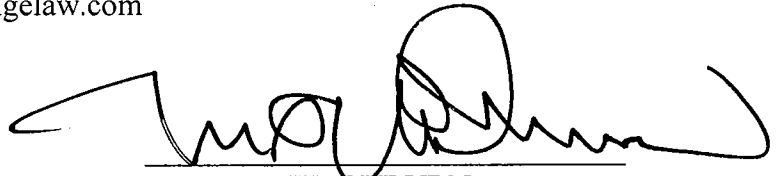
Date: April 23, 2010



**CERTIFICATE OF SERVICE**

I hereby certify that on April 23, 2010, I served a true and complete copy of the foregoing APPLICANT'S ANSWER TO OPPOSER'S AMENDED NOTICE OF OPPOSITION AND COUNTERCLAIMS via email and First Class U.S. Mail, postage pre-paid, upon:

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MARK A. WASHBURN